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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,378	11/02/2001	Guido Baumoeller	H 3954 PCT/US	9714

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COGNIS CORPORATION
PATENT DEPARTMENT
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EXAMINER	
FORTUNA, JOSE A	
ART UNIT	**PAPER NUMBER**
1791	

MAIL DATE	DELIVERY MODE
11/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/913,378	BAUMOELLER ET AL.	
	Examiner	Art Unit	
	José A. Fortuna	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/18/07*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific ratio/range/amounts of the different components of the emulsion to obtain a moist paper as it is now claimed, does not reasonably provide enablement for an open range of the different component of the mixture. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The specification, i.e., Table 1, clearly indicates that the components of the mixture must be within certain range/amount/ratio to obtain an emulsion such that when a tissue/paper is impregnated with such emulsion, the tissue/paper feels moist.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 10-35 the term "moist' renders the claims indefinite because the metes and bound of patent protection cannot be ascertained, i.e., what levels of moist do the claims

encompass? Also the "moist sensation" is user dependent and therefore the metes and bounds cannot be ascertained.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 10-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Haut et al (6,207,014).

Regarding claims 10-27, de Haut et al. disclose the impregnation of paper with an aqueous softening lotion. The lotion contains the following components (last paragraph of column 5):

a) 35-95% fatty alcohol

b) 1-50% waxy esters having a total of 24-48 carbon atoms

c) Up to 20% nonionic/amphoteric emulsifiers

d) Up to 50% mineral oil or wax.

The waxy esters are listed in column 2, lines 27-32 and include the ones recited in present claim 13. The preferred amount of emulsifier is 1.5 -5%, wax is 1-10% see column 8, lines 50-65.

One of the preferred non-ionic polyol emulsifier is in particular polyglycerol poly-12-hydroxystearate, column 7, lines 60-62.

Even though the claims recite the semi-open transitional phrase "consisting essentially of," it is the examiner's opinion that the use of saturated fatty alcohols would not materially change the composition and therefore, the cited reference still reads on the claims. Note that it has been held that "[I]f an application contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F .2d 870, 143 USPQ 256 (CCPA 1964). It is applicant's burden to establish that a step practiced in a prior art method is excluded from his claims by consisting essentially of language. *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. &

Inter. 1989). Thus, at the very least, it would have been obvious to select those components and amounts, which de Haut et al considered to be preferred over other listed components. Therefore one of ordinary skill in the art would have selected the preferred amount of wax and the polyglycerol poly-12-hydroxystearate the non-ionic emulsifier.

Regarding claims 28-35, even though de Haut et al. prefer the use of saturated waxy esters to avoid potential odor problems that some of the unsaturated waxy esters could cause, that in any way teaches away from using unsaturated waxy esters. One of ordinary skill in the art would have reasonable expectations of success if unsaturated ester are used, and can chose if so desire to use unsaturated esters which either: a) won't cause odor problem or b) would use some countermeasure to the odor problem, i.e., using perfume or odor repellent agent. It has been held that "[R]eferences are not limited to preferred embodiments." *In re* Boe, 148 USPQ 507 (CCPA 1966). Also, it has been held that all the disclosure in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. *In re* Smith, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re* Nehrenberg, 47 CCPA 1159, 280 F.2d 161, 126 USPQ 383; and in *In re* Watanabe, 50 CCPA 1175, 315 F.2d 924, 137 USPQ 350.

As to the moist feel, the cited reference teaches that the dry feels refers to the greasy sensation rather than moisture, see column 4, lines 54-59. Therefore, the moist limitation is also inherent to the reference.

Response to Arguments

5. Applicant's arguments with respect to claims 10-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Process of making a Soft Paper."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF